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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/266,183	03/10/1999	MARCO SCIBORA	90020-12	5426
32300	7590	05/03/2005	EXAMINER	
BRIGGS AND MORGAN P.A. 2200 IDS CENTER 80 SOUTH 8TH ST MINNEAPOLIS, MN 55402			FLANDERS, ANDREW C	
			ART UNIT	PAPER NUMBER
			2644	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/266,183

Applicant(s)

SCIBORA, MARCO

Examiner

Andrew C Flanders

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsevdos (U.S. Patent 5,734,719) in view of Alexander (U.S. Patent 5,633,839)

3. Regarding Claim 1, Tsevdos discloses a plurality of preview stations distributed throughout the retail premise (Fig. 14 elements 1303), a plurality of compact disc cutters (Fig. 14 elements 1318), retail host server connected to booths and cd-r's (Fig. 14 element 1408) (i.e. a main computer connected to the memory, to the preview stations and to the compact disc cutters). Tsevdos does not disclose a music memory containing a plurality of digitally stored music selections. Alexander discloses a music vending machine with a disk drive that is a removable hard drive which contains digitally stored musical selections (col. 2 lines 64 – 65) (i.e. a music memory containing a plurality of digitally stored music selections). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Alexander's Music vending machine within Tsevdos' music preview stations to increase the functionality of Tsevdos' system. Alexander discloses if a consumer wishes to own a compact disc recording of his or her favorite musical selections, the consumer either has to buy the entire CD, a single CD, or buy an expensive CD recording system and record off of

radio (col. 1 lines 12 – 37). Alexander's solution is to allow a customer to select multiple music selections and record it to a compact disc (col. 1 lines 58 – 65) rather than have to use one of the three above options. It would be desirable to have this feature available on Tsevdos' system to allow a consumer to custom record a disc with personalized selections.

4. Regarding Claim 2, in addition to the elements stated above regarding claim 1, Alexander further discloses a music vending machine with a disk drive that is a removable hard drive which contains digitally stored musical selections (col. 2 lines 64 – 65) (i.e. wherein the memory comprises at least one hard disc drive).

5. Regarding Claim 3, in addition to the elements stated above regarding claim 1, Tsevdos discloses a system for accessing digital audio information at remotely stored locations (col. 1 lines 18 – 20) (i.e. wherein the music memory is located remotely from the main computer).

6. Regarding Claims 4 - 9, in addition to the elements stated above regarding claim 1 storing music uncompressed, MP3, ADPCM, Real Audio, and Liquid audio encoding were all notoriously well known in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to compress the musical selections in order to save hard drive space.

7. Claims 10 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsevdos (U.S. Patent 5,734,719) in view of Alexander (U.S. Patent 5,633,839) and in further view of Kaplan (U.S. Patent 5,237,157)

8. Regarding Claim 10, in addition to the elements stated above regarding claim 1, Tsevdos discloses a monitor, a sound amplifier and speakers (Fig. 16 elements 1606, 1608 and 1610), compact disc purchase means (Fig. 27), track selection means (Fig. 25). Tsevdos does not disclose a bar code scanner. Kaplan discloses scanning a UPC bar code to bring up audio selections (col. 3 lines 12 – 21). It would have been obvious to one of ordinary skill in the art at the time of the invention to add a bar code reader as taught by Kaplan to Tsevdos and Alexander's combination in order to facilitate customer selection of albums.

9. Regarding Claim 11, in addition to the elements stated above regarding claim 10, Tsevdos discloses speakers (Fig. 16 elements 1608).

10. Regarding Claim 12, in addition to the element stated above regarding claim 10, using headphones to reproduce sound was notoriously well known in the art at the time of the invention. It would have been obvious to one of ordinary skill in the art at the time of the invention to use headphones instead of speakers as the sound reproduction device in order to prevent unnecessary noise throughout a retail environment.

11. Regarding Claim 13, in addition to the elements stated above regarding claim 10, Tsevdos further discloses track selection means with a skip forward and skip backward function (see arrows next to display on Fig. 25)

12. Regarding Claim 14, in addition to the elements stated above regarding claim 10, Tsevdos further discloses a screen with an order button (Fig. 28) (i.e. buy button).

13. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (U.S. Patent 5,633,839) in view of Tsevdos (U.S. Patent 5,734,719) and in

further view of Salisbury (U.S. Patent 6,041,703). The elements referred to from Salisbury are not part of applications 08/760,640 or 09/007,530 and thus receive the priority date of 10 March 1999.

14. Regarding Claim 15 in addition to the elements stated above regarding claim 1, Alexander discloses a microprocessor that then directs the CD writer and dispenser to retrieve a blank compact disk (not shown) from a CD storage and to record the customer's selections onto the compact disk (col. 3 lines 45 – 52) (i.e. a storage for a number of blank compact discs, a mechanism for removing a blank compact disc from the compact disc from the compact disc storage and a mechanism for recording music selected from the music memory on a blank compact disc). Neither Alexander nor Tsevdos disclose a printer adapted to print identifying information on the compact disc. Salisbury discloses placing the compact disc into a printer for printing on a compact disc (i.e. a printer adapted to print identifying information on the compact disc). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Salisbury's printer with the Tsevdos and Alexander combination in order to create a retail compact disc. It would be desirable to print a design on a compact disc in order to mimic a standard pressed retail disc.

15. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander (U.S. Patent 5,633,839) in view of Tsevdos (U.S. Patent 5,734,719) and in further view of Salisbury (U.S. Patent 6,041,703) and in further view of Hwang (U.S. Patent 5,825,726). The elements referred to from Salisbury are not part of applications 08/760,640 or 09/007,530 and thus receive the priority date of 10 March 1999.

16. Regarding Claim 16, in addition to the elements listed above regarding claim 15, Hwang discloses a plurality of track data is recorded in respective sessions, and track information for the corresponding session is recorded in the lead in area of the corresponding session (col. 3 lines 38 – 41) (i.e. data of manufacture, retailer's name and the titles of the music selections are cut into the compact disc). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Hwang's track information writing scheme on the Tsevdos and Alexander combination in order to conveniently locate where a disc was manufactured. It would be desirable to know the details of when the disc was produced for disc failure issues and customer warranty claims.

17. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsevdos (U.S. Patent 5,734,719) in view of Alexander (U.S. Patent 5,633,839) and in further view of Cook (U.S. Patent 5,860,068). The elements referred to from Cook are not part of applications 08/760,640 or 09/007,530 and thus receive the priority date of 10 March 1999.

18. Regarding Claim 17, in addition to the elements listed above regarding claim 1, Cook discloses a gift card (column 5, lines 25 – 32) (i.e. a plurality of scannable purchase cards each having a unique bar code keyed to the music selections chosen by the customer). It would have been obvious to one of ordinary skill in the art at the time of the invention to use Cook's gift card on the Tsevdos and Alexander combination in order to conveniently purchase a CD. Cook's system does essential the same as the

Tsevdos and Alexander combination and it would be desirable to add a gift card feature to facilitate a purchase by a third party.

19. Claims 18 - 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsevdos (U.S. Patent 5,734,719) in view of Alexander (U.S. Patent 5,633,839) and in further view of Kaplan (U.S. Patent 5,237,157) and in further view of Cook (U.S. Patent 5,860,068). The elements referred to from Cook are not part of applications 08/760,640 or 09/007,530 and thus receive the priority date of 10 March 1999.

20. Regarding Claim 18, Tsevdos discloses screens with selections and an order button (Figs. 19 - 28) (i.e. the customer selecting each track to be purchased, up to the authorized amount, by pressing a buy button at the preview station). Tsevdos does not disclose the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel, the customer scanning a disc barcode for a compact disc to be sampled at a preview station, playing each track corresponding to the disc barcode at the preview station, playing each track corresponding to the disc barcode at the preview station, scanning the purchase card to obtain the unique barcode, keying each selected track to the unique barcode, scanning the purchase card at a checkout station to obtain the unique barcode or recording the selected tracks keyed to the unique barcode on a compact disc cutter. Alexander discloses a microprocessor that then directs the CD writer and dispenser to retrieve a blank compact disk (not shown) from a CD storage and to record the customer's selections onto the compact disk (col. 3 lines 45 - 52) (i.e. recording the selected tracks keyed to the unique barcode on a compact disc cutter). It would have been obvious to one of

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ordinary skill in the art at the time of the invention to incorporate Alexander's Music vending machine within Tsevdos' music preview stations to increase the functionality of Tsevdos' system. Alexander discloses if a consumer wishes to own a compact disc recording of his or her favorite musical selections, the consumer either has to buy the entire CD, a single CD, or buy an expensive CD recording system and record off of radio (col. 1 lines 12 – 37). Alexander's solution is to allow a customer to select multiple music selections and record it to a compact disc (col. 1 lines 58 – 65) rather than have to use one of the three above options. It would be desirable to have this feature available on Tsevdos' system to allow a consumer to custom record a disc with personalized selections. Neither Tsevdos nor Alexander disclose the customer obtaining a purchase card with a unique barcode number and an authorized amount from retail premises personnel, the customer scanning a disc barcode for a compact disc to be sampled at a preview station, playing each track corresponding to the disc barcode at the preview station, playing each track corresponding to the disc barcode at the preview station, scanning the purchase card to obtain the unique barcode, keying each selected track to the unique barcode, scanning the purchase card at a checkout station to obtain the unique barcode. Cook discloses a gift card with a number and supplying the gift number to the machine (col. 5 lines 25 – 31) (i.e. the customer obtaining a purchase card with a unique barcode number and scanning the purchase card to obtain the unique barcode and scanning the purchase card at a checkout station to obtain the unique barcode) and a barcode as an identifier for each CD (col. 10 lines 25 – 40) (i.e. keying each selected track to the unique barcode). It would have been

obvious to one of ordinary skill in the art at the time of the invention to use Cook's gift card on the Tsevdos and Alexander combination in order to conveniently purchase a CD. Cook's system does essential the same as the Tsevdos and Alexander combination and it would be desirable to add a gift card feature to facilitate a purchase by a third party. Neither Tsevdos, Alexander or Cook disclose the customer scanning a disc barcode for a compact disc to be sampled at a preview station and playing each track corresponding to the disc barcode at the preview station. Kaplan discloses scanning a UPC bar code to bring up audio selections (col. 3 lines 12 – 21) (i.e. the customer scanning a disc barcode for a compact disc to be sampled at a preview station and playing each track corresponding to the disc barcode at the preview station). It would have been obvious to one of ordinary skill in the art at the time of the invention to add a bar code reader as taught by Kaplan to the Tsevdos, Alexander and Cook combination in order to facilitate customer selection of albums.

21. Regarding Claim 19, as shown above Kaplan and Alexander teach elements b, c, d, e, l, n, o, and p. Cook teaches a, h, j, k, l, and q. Tsevdos teaches f and g. The motivation to combine these elements is stated above regarding claim 18 and thus, claim 19 is rejected.

22. Regarding Claims 20 and 21, the gift card of Cook is implicitly purchased either before or after the tracks are selected.

Response to Arguments

Applicant's arguments filed 30 March 2005 have been fully considered but they are not persuasive.

Applicant asserts Examiner has not established a prima facie case of obviousness. Applicant points to three criteria for providing a prima facie case of obviousness, 1.) Suggestion or motivation to combine, 2.) Reasonable explanation of success, and 3.) The prior art reference must teach or suggest all claim limitations.

Regarding number 1, as stated in the previous office action dated 16 December 2004, it would have been obvious to one of ordinary skill in the art to combine Tsevdos with Alexander. Alexander discloses a music vending machine while Tsevdos discloses an on demand system at a customer premises. Both teach similar inventions with respect to selling a customer a music selection. Therefore, as stated in the action, it would have been obvious to take elements from Alexander and apply them to Tsevdos. In this case, it would be desirable to add the ability to make a custom compact disc (see Alexander col. 1 lines 12 – 37 and col. 1 lines 58 – 65). Because this is disclosed in the Alexander reference, it is not based upon applicant's disclosure.

Regarding number 2, since both Tsevdos and Alexander disclose writing music selections to a CD, there is a reasonable expectation that one could incorporate Alexander into Tsevdos to create custom CDs as disclosed by Alexander. Thus, showing a reasonable expectation of success.

Regarding number 3, as shown in the previous action, the combination discloses all claimed limitations of applicants claimed invention.

As shown above, the previous action has made a case of prima facie obviousness and thus the rejection stands.

Furthermore Applicant asserts that Tsevdos is not 103(a) prior art for any of its teachings used in the present rejection since its filing data (December 10, 1996) is later than the priority data (December 4, 1996) of the present application.

Examiner points to element [63] on page 1 of the Tsevdos reference. In this element, the patent discloses that it is a continuation of an abandoned application that has a priority date of 15 October 1993. A continuation relies on the entire disclosure of the prior application and thus teaches the same invention. As such, the priority date of the Tsevdos reference is not in fact 10 December 1996, but actually 15 October 1993, making it prior art.

Applicant also states that the gift card disclosed by Cook is not scannable or have a unique bar code keyed to the music selections chosen by the customer. However, for the Gift card to function as disclosed by Cook, it would require a number, a bar code, a magnetic strip, or some form of identification so a third party could use it to purchase music selections. A bar code is just an obvious variant of any of these forms of identification and using it does not show the exercise of inventive skill. Having this identification and using it to buy music selections by a third party, as disclosed by Cook, reads upon the limitations of the claim. The identification of the card being scannable and the purchasing of music selections reading upon a unique identification (i.e. bar code) keyed to the music selections chosen by the customer. As such, the rejection stands.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew C Flanders whose telephone number is (571) 272-7516. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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REVISORY PATENT EXAMINER